



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,817	11/04/2003	Tomomi Ikemoto	2003_1605	4435

513 7590 07/12/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

LEE, SUSANNAH E

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,817

Applicant(s)

IKEMOTO ET AL.

Examiner

Susannah Lee

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-48 are pending in this application and are subject to the following new lack of unity requirement.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

Lack of Unity Requirement

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a general inventive concept (requirement of unity of invention) and that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.

Annex B, Part 1(e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

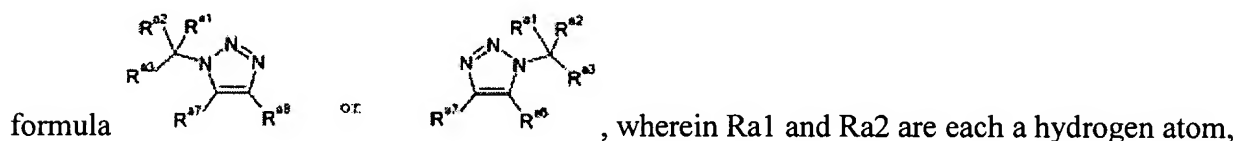
Art Unit: 1626

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specifically designed for carrying out the said process,..."

This application contains the following inventions or groups of inventions, which are not linked to form a single general inventive concept under PCT Rule 13.1.

In addition, due to the numerous variables in the claims, e.g. Ra1, Ra2, Ra3, Ra7, Ra8, etc... and their widely divergent meanings, a precise listing of inventive groups cannot be made. The following groups are exemplary:

Group I: Claims 1-10 and 15 drawn to a method for producing a compound of the



a substituted hydroxyl, a substituted thiol, a substituted amino, an optionally substituted hydrocarbon group, or an acyl; Ra3 is as defined except optionally substituted heterocyclic group; Ra7 and Ra8 are as defined except optionally substituted heterocyclic group, classified in class 548 with plethora of subclasses.

Group II: Claims 1-10 and 15 drawn to a method for producing a compound of the formula of claim 1, wherein Ra1, Ra2, Ra3, Ra7 and Ra8 are each an optionally substituted heterocyclic group, wherein the heterocyclic group is a 5 membered ring with one, two, or three heteroatoms.

Group III: Claims 11, 14 and 16 drawn to a compound of the formula, wherein all variables are as defined and one method of production.

Group IV: Claims 12 and 13 drawn to a compound of the formula wherein, all variables are as defined, and one method of production.

Art Unit: 1626

Group V: Claims 17 and 18 drawn to a compound of the formula wherein, all variables are as defined, and one method of production.

Group VI: Claims 19-26 drawn to a method for producing a compound of the formula wherein, all variables are as defined, except optionally substituted heterocyclic group.

Group VII: Claims 27, 28 and 31 drawn to a method for producing a compound of the formula wherein, all variables are as defined, except optionally substituted heterocyclic group.

Group VIII: Claims 29 and 30 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group IX: Claims 32-35 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group X: Claims 36-38 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XI: Claims 39-41 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XII: Claims 42 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XIII: Claims 43 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XIV: Claims 44 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XV: Claims 45 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

Group XVI: Claims 46-48 drawn to a method for producing a compound of the formula wherein, all variables are as defined.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted. Again this list is not exhausted, as it would be impossible under the time constraints due to the sheer volume of the subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same. If applicant wishes to elect subject matter other than that identified in the above groups, applicant may elect a species and examiner will endeavor to group it.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a substituted or optionally substituted heterocyclic group, which is attached to a core triazole ring that does not define a contribution over the prior art (see U.S. Pat. #6,211,215 and U.S. Pat. #6,716,863). The substituents on the triazole ring vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, the numerous provisos found in the claims, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

Art Unit: 1626

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Lee whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susannah Lee
Patent Examiner, AU 1626

**KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER**

for Kamal Saeed
Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626
Technology Center 1600

Date: 07/06/2005